

REMARKS

Claims 1-42 are now pending in this application. Claims 27 and 28 are withdrawn. Claims 1-26, and 29 are rejected. New claims 30-42 are added. Claims 1, 8, and 14, 18, 20, 23, 26, and 28 are amended herein to place the claims in better form. Claims 25 and 29 are amended herein to clarify the invention and/or to place the claims in better form.

Claim 25 has been rejected under 35 U.S.C. § 112, first paragraph, as not enabled.

Appropriate correction has been made. Applicants respectfully request that the enablement rejection be withdrawn.

Claims 1 and 25-26 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,218,375 (Tanaka et al.).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The present invention is different from the cited art, as explained below.

Claim 1 of the present invention is directed to a method of improving moisture retention ability of skin and/or treating or protecting skin for another purpose. The method of improving moisture retention ability as presently claimed means to improve moisture retention ability of the corneal layer of the epidermis, as

compared with the state of the epidermis before applying the skin conditioner of the present invention. In contrast to temporarily providing moisture to the skin or temporarily providing a barrier mechanism to the skin, the present invention is directed to conditioning the functioning of the corneal layer of the epidermis and this conditioned state is maintained after the application of the skin conditioner has ceased, as briefly discussed on page 2, lines 9-19 of the specification.

In contrast, Tanaka et al. discloses a keloid treating agent and fails to disclose or suggest the above-identified mechanism of moisture retention ability of the present invention. The courts have made clear that "[n]ew uses of old products or processes are indeed patentable subject matter. *Perricone v. Medicis Pharmaceutical Corp.*, 77 USPQ2d 1321, 1328 (Fed. Cir. 2005). Accordingly, the present invention is patentable over Tanaka et al.

Claims 25 and 26 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

Regarding claim 26, the Office Action has not shown that Tanaka et al. discloses or suggest using the agent disclosed in Tanaka et al. to treat skin with the symptoms recited in claim 26. Accordingly, claim 26 is patentable for this reason as well.

Claims 1-26 and 29 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,753,214 (Yoshioka et al.) in view of Tanaka et al. and JP07097312 (JP '312) as evidenced by U.S. Patent No. 6,951,658 (Pearson et al.).

To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974).

The Office Action relies on the teachings of Yoshioka et al. in combination with the teachings of Tanaka et al. for the rejection of claim 1. However, Tanaka et al. is directed to treating keloid and Yoshioka et al. is not directed to treating keloid and therefore there is no reason for one of ordinary skill in the art to use the ethanolamine disclosed in Tanaka et al. in the invention of Yoshioka et al. The Supreme Court has made clear that a claim composed of several elements "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and stated the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *See KSR International Co. v. Teleflex Inc. et al.* 82 USPQ2d 1385, 1396 (2007). In fact, the different purposes of Yoshioka et al. and Tanaka et al. would not prompt one of ordinary skill in the art to combine their teachings. Accordingly, claim 1 is patentable over the cited art and notice to that effect is respectfully requested.

Also, Applicants wish to provide additional explanations regarding the present invention, as embodied in, for example, claim 1. The present invention is directed to a method of improving moisture retention ability of skin and/or treating or protecting skin for another purpose. The present method of improving the moisture retention ability of skin is new and is a concept regarding maintaining or improving the moisture retention ability of skin, in contrast to the concept of a humectant (which simply moisturizes skin). A conventional humectant temporarily maintains moisture at the corneal layer of the epidermis or provides a barrier mechanism to the surface of the skin to temporarily prevent vaporization of moisture and this does not directly act on the function of the epidermis such that when the use of the humectant is stopped or ceased, the skin returns to the state before the use of the humectant, i.e., a dry state of skin.

The method of the present invention is directed to improving a moisture retention ability of the corneal layer of the epidermis as compared with the state of the skin before applying the composition of the claimed invention. Thus, the present invention is directed to improving the function of the corneal layer of the epidermis. Even when the use of the composition on the skin is stopped the moisture retention ability of the skin is maintained.

The composition disclosed in Yoshioka et al. contains the silylated peptide of the formula (I) as an essential component necessary to obtain good results, as is clear from column 26, line 45 to column 39, line 64 of Yoshioka et al. The absence

of the silylated peptide of formula (I) provides poor results, which demonstrates that the L-arginine is not deemed to provide good results. Thus, Yoshioka et al. is distinguishable from the present invention.

Tanaka et al. discloses a keloid treating agent and fails to disclose or suggest the mechanism of moisture retention ability of the present invention.

Accordingly, the present invention is not obvious over Yoshioka et al. and Tanaka et al. and therefore claim 1 is patentable over the cited art and notice to this effect is respectfully requested.

Claims 2-26 and 29 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Regarding claim 2, L-arginine is a species within a genus in Yoshioka et al. and there is no teaching that L-arginine should be used instead of the other components listed in Yoshioka et al. in column 8, line 53 through column 9, line 34. The number of species disclosed in Yoshioka et al. is very large and there is no reason for one of ordinary skill in the art to specifically choose L-arginine and no such reason has been provided by the Examiner. The Federal Circuit has made clear that a broad genus does not necessarily render obvious each species within its scope. *See In re Deuel*, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995). Accordingly, claim 2 is further patentable for this reason as well.

Regarding claim 4, the Office Action has not demonstrated that any of the compounds of claim 1 originate in a rice preparation. Accordingly, claim 4 is further patentable for this reason as well.

Regarding claim 7, the Office Action has not demonstrated that the prior art discloses any rice preparation produced by hydrating rice or crushed rice, reacting it with amylase or protease, and adding yeast to perform saccharification and fermentation. These processes provide a particular rice preparation and the Office Action has not identified that such rice preparation is disclosed or suggested in the prior art. Additionally, the dependency of claim 7 from claim 5, for example, requires that the Office Action identify such rice preparation in the prior art since such rice preparation is included in the composition, as recited in claim 5. Accordingly, claim 7 is patentable for this reason as well.

Regarding claim 8, the Office Action has not demonstrated that the prior art discloses any rice preparation produced by hydrating rice or crushed rice, adding one, two or all of amylase, protease and lipase, heating, and extracting by heating. These processes provide a particular rice preparation and the Office Action has not identified that such rice preparation is disclosed or suggested in the prior art. Additionally, the dependency of claim 8 from claim 5, for example, requires that the Office Action identify such rice preparation in the prior art since such rice preparation is included in the composition, as recited in claim 5. Accordingly, claim 8 is patentable for this reason as well.

Regarding claim 13, the Office Action has not shown a preparation prepared by fermentation. Such fermentation provides a fermented product and the Office Action has not identified where a fermented product is disclosed in the prior art. Additionally, the dependence of claim 13 from claim 11 requires that the Office Action identify such preparation since such preparation is included in the composition, as recited in claim 11.

Regarding claim 14, the Office Action has not demonstrated that the prior art discloses any rice preparation produced by adding water, as necessary, to the animal, plant or microbial material, adding one, two or all of amylase, protease and lipase, heating, and extracting by heating. These processes provide a particular preparation and the Office Action has not identified that such preparation is disclosed or suggested in the prior art. Additionally, the dependency of claim 14 from claim 11, for example, requires that the Office Action identify such preparation in the prior art since such preparation is included in the composition, as recited in claim 11. Accordingly, claim 14 is patentable for this reason as well.

Regarding claim 15, the Office Action has not shown that the cited art discloses or suggests a composition applied to a skin which requires prevention, prevention of exacerbation or treatment of atopic dermatitis.

Regarding claim 17, the Office Action has not shown that the cited art discloses or suggests a composition applied to a skin which requires restoration of the barrier mechanism and function thereof.

Regarding claim 19, the Office Action has not shown that the cited art discloses or suggests a composition applied to a skin which requires conditioning of epidermal keratocytes thereof.

Regarding claim 20, the Office Action has not shown that the cited art discloses or suggests a composition applied to a skin which requires conditioning of an epidermis thereof.

Regarding claim 22, JP'312 discloses a lotion having Aeginetia indica and/or an extract thereof, which is a plant belonging to a class of Magnoliopsida as an effective skin ingredient. The 1,3-butylene glycol is utilized as an extraction solvent. The Office Action has not identified any disclosure in JP'312 stating that the 1,3-butylene glycol is an active ingredient. Accordingly, the Office Action has not provided a reason for one of ordinary skill in the art to utilize the 1,3-butylene glycol of JP'312 in the invention of Yoshioka et al.

Regarding claim 24, the Office Action cites to column 17, lines 24-33 for the presence of an anti-inflammatory agent. However, such disclosure is directed to a permanent waving composition that is not necessarily applied to skin. Accordingly, *prima facie* obviousness has not been demonstrated.

Applicants also wish to point out that the present invention demonstrates synergistic results. The use of both ethanolamine and L-arginine provides synergistic results as is clear from examples 4-6 and Fig. 21 of the present specification. Examples 4 and 5 contain either ethanolamine or L-arginine and Example 6 contains

both. Fig. 21 demonstrates that the combination of both L-arginine and ethanolamine provide synergistic effects resulting in substantially improved results. The courts have made clear that synergism can be evidence of nonobviousness. *See Panduit Corporation v. Dennison Manufacturing Co.*, 227 USPQ 337, 348 (Fed. Cir. 1985). Accordingly, the present invention is further patentable for this reason as well.

Claims 1, 8, 14, 18, 20, and 25 have been amended. New claims 40-42 have been added. Support for the claim amendments can be found in, for example, the claims as filed and in the examples of the specification such as, for example, Examples 1, 2, 3, 4, 7, and 32.

Claims 30-42 are patentable at least because they depend from a patentable base claim.

Applicants respectfully request that the Examiner acknowledge receipt of the priority document(s) filed in this application via U.S. Patent Application No. 09/623,968, which is the grandparent of the present application.

Thirteen further claim(s) in excess of twenty are added. **The fee of \$325.00 for the claim(s) is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

Applicants request a three month extension of time for responding to the Office Action. **The fee of \$525.00 for the extension is provided for in the charge**

authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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